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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/773,319	02/09/2004	Mathilde Winckels	234690US26	6648
22850	7590	02/08/2006	EXAMINER	
OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314			PICKETT, JOHN G	
			ART UNIT	PAPER NUMBER
			3728	
DATE MAILED: 02/08/2006				

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/773,319

Applicant(s)

WINCKELS, MATHILDE

Examiner

Gregory Pickett

Art Unit

3728

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 09 February 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-33 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-7, 10-12, 14-17, 20, 21 and 24-33 is/are rejected.
- 7) ☒ Claim(s) 8, 9, 13, 18, 19, 22 and 23 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 09 February 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>2/9/04</u> . | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Claim Rejections - 35 USC § 102*

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

1. Claims 1-7, 10-12, 14-17, and 20 are rejected under 35 U.S.C. 102(b) as being anticipated by Polsky [US 6,023,866; provided by applicant].

Claims 1 and 7: Polsky discloses a packaging unit **100** [see Figure 3] with a space for holding an article [area for receipt of sheet **111**] and comprising at least one portion **110/120/130** configured such that when seen in a first direction at least a part of the article can be seen, and when in a second direction, different from the first direction, a first decorative motif **I** can be seen. As noted in claim 7, a transparent element may either be a transparent material or an opening. Accordingly, Polsky discloses a transparent element defined by the opening bounded by the front edges of sidewalls **120 & 130** and allowing for the viewing of an article held in the space [area for receipt of sheet **111**]. Polsky further discloses at least one, second element [panel set **C**] extending in a different plane than the transparent opening. It must be noted that the article is not positively claimed and that packaging unit **100** need only be capable of performing the intended use of retaining an article containing a cosmetic product. The examiner asserts that the space [area for receipt of sheet **111**] of packaging unit **100** is fully capable of retaining a sheet-like article containing a cosmetic product [see for

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example, Beal, Jr. US 4,611,611 where in Figure 1, sheet **1** contains a cosmetic product **19/21**] and therefore meets the limitations of claims 1 and 7. The recitation of a new intended use for an old product does not make a claim to that old product patentable. *In re Schneller*, 44 USPQ 2d 1429 (Fed Cir. 1997); *In re Spada*, 15 USPQ 2d 1655 (Fed. Cir. 1990); and *In re Benner*, 82 USPQ 49 (CCPA 1949).

Claims 2, 14, 16, 17: Polsky discloses additional second elements [panel set **B**] containing a second motif I. Polsky anticipates two panel sets [panel sets **B & C**] arranged in back-to-back relationship [Col. 3, lines 45-49] enabling the second motif to be seen from a third, distinct direction.

Claims 3 and 4: Panel sets **B & C** are in the shape of strips.

Claims 5 and 15: Panel sets **B & C** are a plurality of strips in parallel arrangement.

Claim 6: Polsky discloses an opening [front edges of sidewalls **120 & 130**] for the transparent portion.

Claims 10 and 11 are product-by-process claims. Polsky discloses the packaging unit **100** and panel sets **B & C** from plastic [Col. 2, lines 56-58 and Col. 3, lines 24-25]. The method of forming the device is not germane to the issue patentability of the device itself. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process. *In re Thorpe*, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985).

Claim 12: Packaging unit **100** is in the form of a box.

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Claim 20: As previously noted, according to the applicant's definition, a transparent element may either be a transparent material or an opening. Accordingly, Polsky defines a third transparent element [open top, see Figure 3].

2. Claims 21 and 24-33 are rejected under 35 U.S.C. 102(b) as being anticipated by Rieumont [US 4,282,669].

Claim 21: Rieumont discloses a packaging unit **10** with a space **13** suitable for containing an article **14** with at least one portion **16/17** comprising a first element [upper element **21**] of transparent material and a second element **18** having a first motif **23** associated therewith, wherein the at least one portion is suitable for viewing the article **14** in a first direction and the first motif **23** from a second direction. Elements **16** and **17** extend in different planes.

Claim 24: Rieumont discloses second motif **25** viewed from a third direction.

Claim 25: Rieumont discloses a third element [lower element **21**].

Claim 26: An alternate interpretation of Rieumont reveals a packaging unit **10** having a space **13** for holding an article **14** and further comprising at least one first element **16** of transparent material enabling the viewing of article **14** in a first direction, at least one second element **18** with a first surface having a portion **22** of a first motif **23** and extending at an angle perpendicular to first element **16** for viewing the first surface from a second direction as claimed.

Claim 27: the first surfaces of Rieumont are spaced apart as claimed.

Claim 28: the first and second directions of Rieumont are predominantly as claimed [see Figure 1 for the first direction and Figure 5 for the second direction].

Claims 29 and 33: Rieumont discloses a second surface having a portion **24** of a second motif **25** extending at an angle perpendicular to first element **16** for viewing the second surface from a third direction as claimed.

Claim 30: the second surfaces of Rieumont are spaced apart as claimed.

Claim 31: the third direction of Rieumont is predominantly as claimed [see Figure 6].

Claim 32: as disclosed by Rieumont, first motif **23** is not seen from the third direction [see Figure 6] and the second motif **25** is not seen from the second direction [see Figure 5].

### ***Allowable Subject Matter***

3. Claims 8, 9, 13, 18, 19, 22 and 23 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

4. As allowable subject matter has been indicated, applicant's reply must either comply with all formal requirements or specifically traverse each requirement not complied with. See 37 CFR 1.111(b) and MPEP § 707.07(a).

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gregory Pickett whose telephone number is 571-272-4560. The examiner can normally be reached on Mon-Fri, 11:30 AM - 8:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mickey Yu can be reached on 571-272-4562. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

*GP*

Greg Pickett  
Examiner  
30 January 2006



ANTHONY D. STASHICK  
PRIMARY EXAMINER